APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,514	01/04/2001	Yasuyuki Fujikawa	1506.1002 (JDH)	3098

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EXAMINER
SAIN, GAUTAM

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/753,514	FUJIKAWA, YASUYUKI
	Examiner	Art Unit	
	Gautam Sain	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*24 June 2005*</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 4-15* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 4-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1)   This is a NonFinal rejection in response to the amendments/remarks filed via

RCE on 6/24/05.

2)   Claims 1, 2, 4-15 are pending and rejected in this rejection. Claim 3 is cancelled.

3)   The effective filing date is 2/4/00 (based on foreign priority).

4)   Examiner withdraws the rejection under 35 USC 112 since Applicant corrected

the indefinite claim language.

5)   The Examiner withdraws the previous assertion of Claims 4 and 5 as Allowable

Subject Matter based on further consideration in view of the amendments/arguments

with the original specifications/drawings (see 103 rejection below).

6)   Examiner introduces a new line of rejection under 35 USC 101.

Continued Examination Under 37 CFR 1.114

7)   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/24/05

has been entered.

Claim Rejections - 35 USC § 101

8)   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

8-1)   Claims 1, 2, 4-10,12-15 rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter. Claims 1, 2, 4-10,12-15 set forth

nonfunctional descriptive material but fail to set forth physical structures or materials

comprising of hardware of a combination of hardware or a combination of hardware and

software within the technological arts (ie., a computer) to produce a "useful, concrete

and tangible" result. For example, Claims 1, 2, 4-10,12-15 "system" reads on a mental

construct/abstract idea or at best a computer program, per se. The calim language

does not clearly define structural elements and is not tangibly embodied on a computer

readable medium. Claims 1, 2, 4-10,12-15are interpreted as software per se, abstract

ideas or mental construct and not tangibly embodied on a computer readable medium

or hardware.

Claim Rejections - 35 USC § 103

9)   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

9-1)   Claims 4, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over

<u>Kuwahara</u> (US 6202072, filed Dec 1997).

Claim 4, Kuwahara suggests the amendments to the claim "wherein said ... lower-order

hierarchy", "said retrieving ... higher-order hierarchy" and "said structured document ...

lower-order hierarchy" (ie., for conversion from plain text to an SGML document with

the document having a specific form by referring to the conversion table, using a

document type definition, thereafter adding adding tags to data that is arranged in a

hierarchical manner (where staff encompasses name and department date, as shown in

fig 2) and the tags are flank the content data ("development" inputed in the position in

between the <Department> and </Department> tags)(col 3, lines 5-24; col 6, lines 2-10;

lines 40-50; Fig 2, "Document Type Definition"; Fig 1, items 108 to item 102; Fig 3, item

(b) to (c) to (d) shows the plain text, hierachical structure and SGML output)

Kuwahara does not expressly teach "repetitive structure" but does suggest it, because

Kuwahara teaches that the prior art teaches a repetitive structure (ie., conventional

technology generates every time for the entire document type definition processing

instead of only once)(col 2, lines 45-50), showing that the repetitive is already well

known in the conventional art.

It would have been obvious to one of ordinary skill in the art at the time of the invention

to modify Kuwahara to includes generating conversion tables every time (instead of

once) as suggest in the prior art of conventional technology, providing the benefit

correlating fields of the prototype document to tags of the document type definition

when converting plain text to SGML (Kuwahara, col 2, lines 36-44).

Claim 5, Kuwahara suggests the amendments to the claim "wherein said ... lower-order

hierarchy", (ie., for conversion from plain text to an SGML document with the document

having a specific form by referring to the conversion table, using a document type

definition, thereafter adding adding tags to data that is arranged in a hierarchical

manner (where staff encompasses name and department date, as shown in fig 2) and

the tags are flank the content data ("development" inputed in the position in between the

<Department> and </Department> tags)(col 3, lines 5-24; col 6, lines 2-10; lines 40-50;

Fig 2, "Document Type Definition"; Fig 1, items 108 to item 102; Fig 3, item (b) to (c) to

(d) shows the plain text, hierachical structure and SGML output).

Kuwahara teaches "said retrieving module extracts [ ] conincident with one higher order

hierarchy" (ie., the conversion of a plain text document having a *specific* form to a

SGML document; examiner interprets that in order to have a specific form, there must

be some condition of specificity in order to perform the conversion which is found out

from the document type definition)(col 6, lines 13-36; col 5, lines 50-55 that necessitates

a structure for each of the fields – name, department, and address which are the

elements – in conjunction with the teachings of Nakatsuyma (see details below))(Fig 2,

"Document Type Definition"; Fig 1, items 108 to item 102; Fig 3, item (b) to (c) to (d)

shows the plain text, hierachical structure and SGML output).

Kuwahara does not teach "each region", but does suggest it, because Kuwahara

teaches that the prior art teaches a repetitive structure (ie., conventional technology

generates every time for the entire document type definition processing instead of only

once)(col 2, lines 45-50), showing that the repetitive is already well known in the

conventional art and in order for the repetitive processing, different areas have to be

processed as separate regions/areas.

It would have been obvious to one of ordinary skill in the art at the time of the invention

to modify Kuwahara to includes generating conversion tables every time (instead of

once) as suggest in the prior art of conventional technology, providing the benefit

correlating fields of the prototype document to tags of the document type definition

when converting plain text to SGML (Kuwahara, col 2, lines 36-44).

9-2) Claims 1, 2, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15 are rejected under 35 U.S.C.

103(a) as being unpatentable over Kuwahara (US 6202072, filed Dec 1997), in view

of Nakatsuyama et al (US 5752021, issued May 1998).

Regarding claim 1, Kuwahara teaches "a reading module ... an identifier

thereof" (ie., SGML conversion form generation module SGML document read-in

module)(col 5, lines 1-18, lines 59-65).

Kuwahara teaches "a retrieving module which refers to the extraction ... target

electronic document" (ie., the conversion of a plain text document having a *specific* form

to a SGML document; examiner interprets that in order to have a specific form, there

must be some condition of specificity in order to perform the conversion which is found

out from the document type definition)(col 6, lines 13-36; col 5, lines 50-55 that

necessitates a structure for each of the fields – name, department, and address which

are the elements – in conjunction with the teachings of Nakatsuyma (see details

below)).

Kuwahara teaches "a structure document generating module ... the definition

information" (ie., generate a SGML document from a plain text document prepared by a

user as part of the two directional conversion between plain text document and a SGML

document having a specific form)(col 4, lines 8-13).

Kuwahara suggests the amendments to the claim "wherein said ... lower-order

hierarchy", "said retrieving ... higher-order hierarchy" and "said structured document ...

lower-order hierarchy" (ie., for conversion from plain text to an SGML document with

the document having a specific form by referring to the conversion table, using a

document type definition, thereafter adding adding tags to data that is arranged in a

hierarchical manner (where staff encompasses name and department date, as shown in

fig 2) and the tags are flank the content data ("development" inputed in the position in

between the <Department> and </Department> tags)(col 3, lines 5-24; col 6, lines 2-10;

lines 40-50; Fig 2, "Document Type Definition"; Fig 1, items 108 to item 102; Fig 3, item

(b) to (c) to (d) shows the plain text, hierachical structure and SGML output).

Kuwahara does not expressly teach, but Nakatsuyama suggests "a condition of a

pattern of a character string of plain text data as" (col 3, lines 20-25, ie., retrieval

conditions on the basis of the retrieval formula for defining the structure of the document

data, lines 13-15).

It would have been obvious to one or ordinary skill in the art at the time of the

invention to modify Kuwahara to include retrieval conditions on the basis of the retrieval

formula for defining the structure of document data as taught by Nakatsuyama,

providing the benefit of a document retrieving means to perform retrieval using semantic

description and the schema relating to the first schema and directed to the first retrieval

and converts the first formula to a second formula (Abstract section).

Regarding claim 2, Kuwahara teaches "a reading module ... an identifier

thereof" (ie., SGML conversion form generation module SGML document read-in

module)(col 5, lines 1-18, lines 59-65).

Kuwahara teaches "a retrieving module which refers to the extraction ... target electronic document" (ie., the conversion of a plain text document having a *specific* form to a SGML document; examiner interprets that in order to have a specific form, there must be some condition of specificity in order to perform the conversion which is found out from the document type definition)(col 6, lines 13-36; col 5, lines 50-55 that necessitates a structure for each of the fields – name, department, and address which are the elements – in conjunction with the teachings of Nakatsuyma (see details below)).

Kuwahara teaches "a structure document generating module ... the definition information" (ie., generate a SGML document from a plain text document prepared by a user as part of the two directional conversion between plain text document and a SGML document having a specific form)(col 4, lines 8-13).

Kuwahara suggests the amendments to the claim "said structured document ... lower-order hierarchy" (ie., for conversion from plain text to an SGML document with the document having a specific form by referring to the conversion table, using a document type definition, thereafter adding adding tags to data that is arranged in a hierarchical manner (where staff encompasses name and department date, as shown in fig 2) and the tags are flank the content data ("development" inputed in the position in between the <Department> and </Department> tags)(col 3, lines 5-24; col 6, lines 2-10; lines 40-50; Fig 2, "Document Type Definition"; Fig 1, items 108 to item 102; Fig 3, item (b) to (c) to (d) shows the plain text, hierachical structure and SGML output)

Kuwahara does not expressly teach, but Nakatsuyama suggests "a condition of a pattern of a character string of plain text data as" (col 3, lines 20-25, ie., retrieval conditions on the basis of the retrieval formula for defining the structure of the document data, lines 13-15).

It would have been obvious to one or ordinary skill in the art at the time of the invention to modify Kuwahara to include retrieval conditions on the basis of the retrieval formula for defining the structure of document data as taught by Nakatsuyama, providing the benefit of a document retrieving means to perform retrieval using semantic description and the schema relating to the first schema and directed to the first retrieval and converts the first formula to a second formula (Abstract section).

Regarding claim 6, 7, Kuwahara teaches "extraction condition ... whole region to be extracted" in claim 6 and "extraction condition ... end part thereof" in claim 7 (ie., Plain text document ... "document for Application" and corresponding end tag "document for application")(fig 3, item c)(ie., correlation therebetween as one unit)(col 5, lines 60-65).

Regarding claim 8, 9, Kuwahara teaches "description pattern ... to be extracted" (ie., in the plain text document "application form for registering e-mail address"; data displayed)(Fig 3, item a; col 6, lines 23-26).

Regarding claim 10, Kuwahara teaches "extraction condition ... syntax element of the region to be extracted" (ie., text document is analyzed by software for syntax and tags indicating a ... obtained syntax)(col 1, lines 31-40).

Regarding claim 11, Kuwahara teaches "reading ... text format", "reading ...

identifier thereof" (ie., conversion form generation module, document read-in

module)(col 5, lines 1-20, lines 59-63).

Kuwahara teaches "referring to ... reading step", "extracting ... electronic

document", "combining the regions ... definition information" (ie., specific form ..

concrete data ... name field, address field; data correlating)(col 6, lines 11-27; col 5,

lines 20-30; fig 2; fig 7, item 5).

Kuwahara teaches "generating ... definition information" (col 8, lines 33-38; fig 8).

Kuwahara does not expressly teach, but Nakatsuyama teaches "a condition of a

pattern of a character string of plain text data as" (col 3, lines 20-25, ie., retrieval

conditions on the basis of the retrieval formula for defining the structure of the document

data, lines 13-15).

It would have been obvious to one or ordinary skill in the art at the time of the

invention to modify Kuwahara to include retrieval conditions on the basis of the retrieval

formula for defining the structure of document data as taught by Nakatsuyama,

providing the benefit of a document retrieving means to perform retrieval using semantic

description and the schema relating to the first schema and directed to the first retrieval

and converts the first formula to a second formula (Abstract section).

Regarding claim 12, Kuwahara teaches *reading plain text data; reading*

definition information that defines a correlation between elements as basic units

configuring a document structure of a structured document, and that defines, for each of

the elements [.] and an identifier thereof (ie., SGML conversion form generation module

SGML document read-in module)(col 5, lines 1-18, lines 59-65).

Kuwahara teaches *referring to the extraction condition per element that is*

defined by the reading definition information; extracting a region coincident with the per-

element extraction condition referred to out of the processing target electronic document

(ie., prototype file of a plain text document)(col 5, lines 27, fig 2, item 105).

Kuwahara teaches *combining the regions extracted with respect to the respective*

elements in accordance with the correlation between the respective elements that is

defined by the definition information (ie., generate a SGML document from a plain text

document prepared by a user as part of the two directional conversion between plain

text document and a SGML document having a specific form)(col 4, lines 8-13).

Kuwahara does not expressly teach, but Nakatsuyama teaches *a condition of a*

pattern of a character string of plain text data as (col 3, lines 20-25, ie., retrieval

conditions on the basis of the retrieval formula for defining the structure of the document

data, lines 13-15).

It would have been obvious to one or ordinary skill in the art at the time of the

invention to modify Kuwahara to include retrieval conditions on the basis of the retrieval

formula for defining the structure of document data as taught by Nakatsuyama,

providing the benefit of a document retrieving means to perform retrieval using semantic

description and the schema relating to the first schema and directed to the first retrieval

and converts the first formula to a second formula (Abstract section).

Regarding claim 13, Kuwahara teaches *generating the structured document by adding to each region an identifier defined by the definition information* (ie., generate a SGML document from a plain text document prepared by a user as part of the two directional conversion between plain text document and a SGML document having a specific form)(col 4, lines 8-13).

Regarding claim 14, Kuwahara teaches a *reading module that reads definition information defining a correlation between elements as basic units configuring the document structure, and defining, for each of the elements, [..] and an identifier thereof,* (ie., SGML conversion form generation module SGML document read-in module)(col 5, lines 1-18, lines 59-65).

Kuwahara teaches *a retrieving module which refers to the extraction condition per element that is defined by the definition information read by said reading module, and that extracts a region coincident with the per-element extraction condition referred to out of the processing target electronic document* (ie., prototype file of a plain text document)(col 5, lines 27, fig 2, item 105).

Kuwahara does not expressly teach, but Nakatsuyama teaches *a condition of a pattern of a character string of plain text as an extraction condition* (col 3, lines 20-25, ie., retrieval conditions on the basis of the retrieval formula for defining the structure of the document data, lines 13-15).

It would have been obvious to one or ordinary skill in the art at the time of the invention to modify Kuwahara to include retrieval conditions on the basis of the retrieval formula for defining the structure of document data as taught by Nakatsuyama,

providing the benefit of a document retrieving means to perform retrieval using semantic

description and the schema relating to the first schema and directed to the first retrieval

and converts the first formula to a second formula (Abstract section).

Regarding claim 15, Kuwahara teaches *a structured document generating*

module that combines the regions extracted with respect to the respective elements by

said retrieving module in accordance with the correlation between the elements that is

defined by the definition information (ie., generate a SGML document from a plain text

document prepared by a user as part of the two directional conversion between plain

text document and a SGML document having a specific form)(col 4, lines 8-13).

Response to Arguments

Applicant's arguments filed 6/24/05 have been fully considered but they are not

persuasive. Applicant argues (bottom, page 8) for Claims 1, 2, 11, 12, and 14 that the

Kuwhara in view of Nakatsuyama do not teach the features of the claims *as amended.*

The Examiner disagrees and provides a detailed rejection for the claims as amended

(see above rejection for details).

Applicant argues (on page 9, top) that Kuwhara in view of Nakatsuyama does not

teach the claimed limitations "retrieving ... document". The examiner disagrees and

provides a more detailed explanation in the rejection (see above rejection). Applicant

argues (on bottom of page 9) that Kuwhara in view of Nakatsuyama does not teach the

amended claimed limitations "correlation ... hierarchy". The applicant is arguing the

claims as amended, for which The Examiner disagrees and asserts a more detailed

rejection to address the amended portions of the limitations (see rejection above for details).

Applicant argues (on page 10) that Kuwahra teaches away from a reasonable chance of success because it teaches comparison comments. The Examiner disagrees because Applicant's claims do not preclude 'comparison of comments'. With a broad reasonable interpretation of the claims, converting "plain text data" encompasses comments. Thus the Examiner maintains the motivation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam Sain whose telephone number is 571-272-4096. The examiner can normally be reached on M-F 9-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GS

WILLIAM BASHORE
PRIMARY EXAMINER
10/15/2005